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TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.

ARC920000067US2 (13521)

In Re Application Of: Emanuel I. Cooper, et al.

FEB 19 2004

Serial No.
09/634,171

Filing Date
8/9/2000

Examiner
J.P. Sheehan

Group Art Unit
1742

Title: CoFe ALLOY FILM

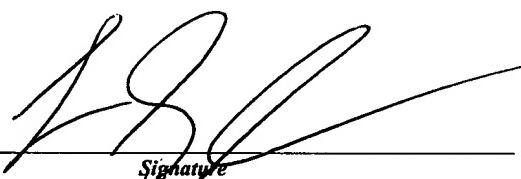
TO THE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE:

Transmitted herewith is:

Petition under 37 C.F.R. 1.181

in the above identified application.

- No additional fee is required.
 A check in the amount of \$130.00 is attached.
 The Director is hereby authorized to charge and credit Deposit Account No. 19-1013/SSMP as described below.
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Signature

Dated: February 17, 2004

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I certify that this document and fee is being deposited on 2/17/2004 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.



Signature of Person Mailing Correspondence

CC:

Leslie S. Szivos, Ph.D

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Emanuel I. Cooper, et al.

Examiner: J.P. Sheehan

Serial No.: 09/634,171

Art Unit: 1742

Filed: August 9, 2000

Docket: ARC920000067US1 (13521)

For: CoFe ALLOY FILM

Dated: February 17, 2004

Confirmation No.: 5758

Commissioner for Patents
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.181

Sir:

In accordance with the provisions of 37 C.F.R. § 1.181, applicants hereby request that the Final Rejection dated September 15, 2003, was premature and hereby submit that the same be withdrawn.

In response to the Office Action dated April 7, 2003, in which Claims 1-20, 28 and 29 were finally rejected under 35 U.S.C. § 102(b) as allegedly anticipated by, or in the alternative, under 35 U.S.C. § 103 as allegedly unpatentable over the article to E.M. Kakuno, et al., "Structure, Composition, and Morphology of Electroplated $\text{Co}_x\text{Fe}_{1-x}$

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

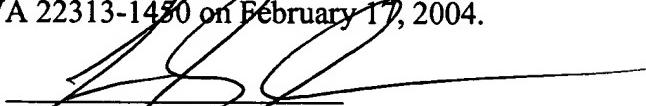
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450 on February 17, 2004.

Dated: February 17, 2004

02/23/2004 AWONDAF1 00000052 09634171

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Leslie S. Szivós, Ph.D.

Alloys”, J. Electrochemical Soc., Col. 144, No. 9 September 9, 1997, pp. 3222-3226 (“Kakuno, et al.”), applicants filed a Request for Continued Examination (RCE) on July, 7, 2003. Accompanying the RCE was a Preliminary Amendment that included remarks for traversing the anticipation and obviousness rejection together with a new Claim 30. Claims 1-20, 28 and 29, of which Claims 1 and 29 are independent, were not amended in the Preliminary Amendment.

Independent Claims 1 and 29 read as follows:

Claim 1. A cobalt-iron binary alloy electroplated film having a saturation magnetization of at least about 2.30 Tesla, said film being substantially free of oxygen and iron oxide, anisotropic and consisting of a binary alloy (100%-x) Co(x)Fe, where x is between about 55% and about 75% by weight.

Claim 29. A magnetic recording head comprising a cobalt-iron binary alloy electroplated film having a saturation magnetization of at least about 2.30 Tesla, said film being substantially free of oxygen and iron oxide, anisotropic and consisting of a binary alloy (100%-x) Co(x)Fe, where x is between about 55% and about 75% by weight.

As stated above, new Claim 30 was introduced into the present application for the first time in the Preliminary Amendment that accompanied the RCE submission. New Claim 30 reads as follows:

Claim 30 (Currently Added) A cobalt-iron binary alloy electroplated film having a saturation magnetization of at least about 2.30 Tesla, a thickness of not more than 2 microns and a substantially smooth, bright surface, said film being substantially free of oxygen and iron oxide, anisotropic and consisting of a binary alloy (100%-x) Co(x)Fe, where x is between about 55% and about 75% by weight.

Applicants submit that new Claim 30 is different from independent Claim 1 since it contains the feature that the cobalt-iron binary alloy electroplated film has a substantially smooth, bright surface. The foregoing feature was not present in any of

Claims 1-20, 28 and 29. Despite that addition of the new claim containing a feature that was not previously being examined, the Examiner issued a Final Rejection dated September 15, 2003. The Final Rejection indicated that all the claims, including the newly added Claim 30, were rejected under 35 U.S.C § 102(b) as allegedly anticipated by, or in the alternative, under 35 U.S.C. § 103 as allegedly unpatentable over the article to E.M. Kakuno, et al.

In the Final Rejection dated September 15, 2003, the Examiner justified his action by indicating that “[A]ll claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.”

Applicants hereby submit that the Examiner has prematurely issued a Final Action in this case in which a new claim that contained a feature not previously considered or searched was introduced in the RCE filing. Applicants respectfully submit that new Claim 30 further limits the claims to a film that has a substantially smooth and bright surface. Such a film was not part of the originally filed claims nor was it present in any of the dependent claims in applicants earlier application, USSN 09/634,171.

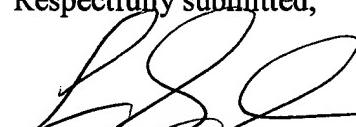
Applicants observe that under the provisions of 37 C.F.R. § 1.113, a Final Rejection is proper if “[O]n the second or any subsequent examination or other action may be made final...”. The Final Rejection issued in the RCE dated September 15, 2003 is improper since Claim 30 has not undergone any examinations prior to the issuance of the Final Rejection. Hence, applicants respectfully submit that the Final Rejection of September 15, 2003 in the RCE is premature given that Claim 30 had not yet been examined in the earlier application or the RCE.

Applicants further note that in the rejections citing Kakuno, et al. made in the Final Rejection dated September 15, 2003, the Examiner failed to specifically address new Claim 30 and mention where Kakuno, et al. discloses applicants' claimed film recited in Claim 30.

In view of the above remarks, applicants respectfully submit that the Final Rejection in the RCE dated September 15, 2003 is premature; therefore withdrawal of the Final Rejection is respectfully requested.

In accordance with the schedule set out in C.F.R. § 1.181, applicants enclose a check in the amount of \$ 130.00.

Respectfully submitted,



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